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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,376	04/17/2001	David A. Jablow	Jablow 2	5786

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HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 8910  
Reston, VA 20195

EXAMINER

ISMAIL, SHAWKI SAIF

ART UNIT PAPER NUMBER

2155

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/835,376	<b>Applicant(s)</b> JABLOW, DAVID A.	
	<b>Examiner</b> Shawki S. Ismail	<b>Art Unit</b> 2155	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8-24, 27-39 and 42-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-24, 27-39, 42-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **RESPONSE TO AMENDMENT**

1. This communication is responsive to the Appeal Brief filed on November 21, 2005. Claims 1, 20 and 35 have been amended. Claims 6-7, 25-26 and 40-41 have been cancelled. Claims 1-5, 8-24, 27-39 and 42-52 are pending.

### **The New Grounds of Rejection**

2. Applicant's arguments have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made.

3. The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

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This list of examples is not intended to be exhaustive. See also MPEP § 2111.04. USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.").

### **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 1, 20 and 35 are rejected under 35 U.S.C. § 112, first paragraph, as being of undue breadth.

A "single means" claim, i.e. where a means recitation does not appear in combination with another recited element or means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. See *In re Hyatt*, 218 USPQ 195, (CAFC 1983) and MPEP 2164.08(a).

2164.08(a) Single Means Claim

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In *re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Although the court in *Fiers v. Sugano*, 984 F.2d 164, 25 USPQ2d 1601 (Fed. Cir. 1993) did not decide the enablement issue, it did suggest that a claim directed to all DNAs that code for a specified polypeptide is analogous to a single means claim.

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 8-24, 27-39 and 42-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Aronin** U.S Patent No. **6,454,650** and in view of **Ruckdashel** U.S. Patent No. **6,144,942**.

8. As to claim 1, Aronin teaches a system for providing personalized notification comprising:

a controller adapted to compare personal information and administrative information related to an event a user is participating in and further adapted to send a personalized notification to the user concerning the user's participation in the event (col. 9, lines 1-8).

Although Aronin discloses sending notification to a participant concerning the user's participation in the event, Aronin does not explicitly teach using a user's preferred method of notification.

Ruckdashel teaches a method for notifying an individual of a previously scheduled event. The user configures how he or she wishes to be notified for a

particular appointment. The notification methods include wireless pager, email, wireless telephone etc...(see abstract, see Figs 5 and 7, col. 5, lines 21-36).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the teaching of Ruckdashel into the invention of Aronin in order to allow the user to specify the preferred notification method. This will allow the user to select the notification medium that best suite them and one that they will have access to the fastest.

9. As to claim 2, Aronin teaches wherein the event is a lottery (see abstract).

10. As to claims 3-5, It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Aronin in view of Ruckdashel so that notification can apply to any event whether it is lottery or sport or entertainment, because the overall functionality of the system will be the only the type of notification will differ and doing so will give the user access to the information at a faster rate as well as add convenience to the user that he or she will be kept up to date with information concerning events that they are participating in.

11. As to claims 8-11, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Aronin in view of Ruckdashel so that the notification can be sent via any type of communication medium whether it be e-mail, telephone, fax etc..., because this will allow the user to select the notification medium that best suite them and one that they will have access to the fastest.

12. As to claim 12, Aronin teaches the system as in claim 1 wherein the controller comprises a server (see Fig. 1).

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13. As to claim 13, Aronin teaches the system as in claim 1 wherein the controller comprises an Internet server (see Fig. 1, col. 5, lines 1-7).

14. As to claim 14, Aronin teaches the system as in claim 1 further comprising a user database adapted to store the personal information (Fig. 1, system database 36).

15. As to claim 15, Aronin teaches the system as in claim 1 further comprising an administrative database adapted to store the administrative information (Fig. 4, col. 8, lines 56-58).

16. As to claim 16, Aronin teaches the system as in claim 1 further comprising a user network access unit adapted to send the personal information to the controller (Fig. 4, col. 8, lines 56-67).

17. As to claim 17, Aronin teaches the system as in claim 1 further comprising an administrative network access unit adapted to send the administrative information to the controller (Fig. 4, col. 8, lines 56-67).

18. As to claim 18, Aronin teaches the system as in claim 1 wherein the personal information comprises a lottery number (col. 7, lines 43-64).

19. As to claim 19, Aronin teaches the system as in claim 1 wherein the administrative information comprises a winning lottery number (Fig. 4, col. 8, lines 56-67).

20. Claims 20-24, 27-39 and 42-52 do not teach or define any new limitation above claims 1-5 and 8-19, therefore, they are rejected for similar reasons.



### **Response to Arguments**

21. Applicant's arguments with respect to claim 1-5, 8-24, 27-39 and 42-52 have been fully considered but are moot in view of the new ground(s) of rejection.

### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shawki Ismail  
Patent Examiner  
February 21, 2006



SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER